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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,945	01/13/2004	Sergio Landau	BJT 334A	3294

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EXAMINER

HAYES, MICHAEL J

ART UNIT	PAPER NUMBER
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3767

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,945

Applicant(s)

LANDAU ET AL.

Examiner

Michael J. Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the marking device" in the second last line.

Claim 8 recites "the nozzle" in the fourth line.

Claim 12 recites "the surface of an injection recipient.

There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 4, 8, 9, 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over MIZZY et al. (US Patent No. 3,859,996) in view of HOGAN (US Patent No. 6,264,637) and LANDAU (US Patent No. 4,592,742). Mizzy discloses an injector including a syringe assembly to expel fluid out a nozzle, and a pressurized gas delivery mechanism. Mizzy does not disclose a marking assembly to place a mark near an injection site nor a needle-free

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injector. Hogan teaches using a marking assembly fluidly coupled to the injection device to mark an injection site having a fluid reservoir 81, nib 85, and an exhaust gas pathway. The gas not directed to the injector assembly is considered the exhaust gas. See figs. 1-4; col. 6, ll. 40-50. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Hogan in the injector of Mizzy in order to provide a convenient method of determining who received injections and the location of the injections. The use of a needle-free injector is taught by Landau. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Landau in the device of Mizzy and Hogan to provide an injector that helps overcome a recipient's fear of needles.

Allowable Subject Matter

Claims 5-7 and 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant argues that the combination of Mizzy and Hogan fail to teach marking by exhaust gas after an injection. The examiner maintains the rejection because Applicant is arguing limitations not found in the claims. Claim 8 recites a marking device activated by exhaust gas and claim 13 recites an exhaust pathway to the marking assembly. Neither claim 8 or 13 recite the activation of the marking assembly after the injection (i.e., post injection). Furthermore Hogan discloses that the injection and the marking occurs substantially

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simultaneously (col. 3, ll. 25-45). This disclosure suggests the marking can occur after the injection because it need not occur exactly simultaneously with the injection. The presence of exhaust gas after injection, even immediately after injection and in small amounts is suggested by the prior art. Applicant's recitation of post-injection does not establish how long after injection nor that the marking assembly starts to operate after the injection is made.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. BUNYAN (US Patent No. 5,935,111) shows a marking injector.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Hayes at (571) 272-4959. The examiner can usually be reached Monday -Thursday, 7:00-4:30, and on alternate Fridays. The fax number for submitting official papers is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjh
1 April 2006


MICHAEL J. HAYES
PRIMARY EXAMINER